

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/716,360 08/03/99 MABBOTT

R 16286-702

EXAMINER

IM52/0523

MICHAEL MURPHY
WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO CA 94304-1050

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774
DATE MAILED:

05/23/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/716,360

Applicant(s)
Mabbott, et al.

Examiner
Grendzynski, Michael E.

Art Unit
1774



-- Th MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 12, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 53-59 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 53-59 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

Art Unit: 1774

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Examiner inadvertently instructed applicants to renumber the claims starting with claim 30. The preliminary amendment of 8/3/99 canceled claims 1-26, and submitted new claims. The numbering of these claims should have begun with number 27 (ending at number 52). With the filing of the response to the restriction requirement, applicants canceled all claims and submitted replacement claims. The numbering of these claims should begin at 53. Consequently, misnumbered claims 30-36 have been renumbered to 53-59.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 53-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact structure of the material is unclear. Does the material comprise a substrate (carrier) and an image-receiving layer comprising polymethylpentene, or is the carrier itself comprised of polymethylpentene? Presently, applicants seem to be claiming numerous variations of embodiments in the independent claim, thus creating ambiguity. For the purposes of examination, examiner will assume the invention comprises a carrier

Art Unit: 1774

layer with a layer of polymethylpentene material (film or coating) thereon. Additionally, with regard to claim 56 "suitable for carrying a toner image" renders the claim ambiguous. The phrase is neither defined in the specification, nor does it have a well-defined meaning in the art. What makes the material suitable for carrying a toner image? How is it suitable? What would make something "unsuitable"?

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 53 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitsubishi Paper Mills (JP 04-039090). Applicants claim a material comprising a carrier layer (made of paper) and a layer thereon comprising a polymethylpentene material. Mitsubishi discloses a support for hot transfer comprising a carrier layer of paper and a recording layer comprising a polymethylpentene resin. *See Abstract*. The limitations of the claim are met by the disclosure of the reference.

Claim Rejections - 35 U.S.C. § 103

6. Claims 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi Paper Mills (JP 04-039090). With specific regard to claims 28-33, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Coating thickness is a conventional concern in the art. Coating thickness is maintained within a desired range to ensure that a printing medium will pass through a

Art Unit: 1774


printer. Additional coating thickness provides the desired level of coverage on a substrate to provide a desired amount of ink receptivity. Consequently, it would be obvious to optimize. Similarly, base weight of a substrate is a conventional concern in the art, because it, for example, provides the desired degree of stiffness of a substrate which is receiving a coating, in order to prevent curling. Consequently, it would be obvious to optimize.

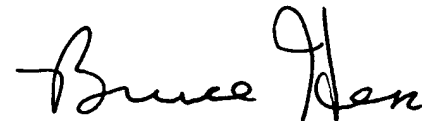
Conclusion

7. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.


Michael E. Grendzynski
Assistant Examiner
May 21, 2001



BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300